

### REMARKS

Claims 1-54 have been amended to further patentably distinguish the invention from the prior art. Such amendments to the claims are only for the purpose of advancing the prosecution of this application and are not to be construed as an abandonment of any of the novel concepts disclosed therein.

The courtesy of the Examiner in withdrawing the Requirement for Restriction is acknowledged with appreciation.

The office action states:

Claims 1-3, 5, 10-12, 14-16, 18, 23-25, 38-39, 41 and 46-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Kerns [US 3,376,523].

Kerns discloses a transformer [figures 1-4] for use in a power supply circuit including a rectifying circuit, comprising:

- a core structure including first and second core elements [17, 18 or 54, 56];
- a first shielding device [51] constructed and arranged to electrically shield the first core element from the second core element;
- a second shielding device [53] constructed and arranged to electrically shield the second core element from the first core element;
- at least one first coil [19, 21 or 59, 61] wound about the first core element;
- at least one second coil [22, 23 or 62, 63] wound about the second core element; and
- input/output terminals [24, 26, 27, 28] connected to ends of the first and second coils; wherein the first and second shielding device, each comprises an electrically insulating substrate [57 or 58] and a pattern of electrically conductive material disposed on the substrate.

Regarding claims 5, Kerns discloses the first shielding device disposed so that the electrically conductive pattern faces the at least one first coil.

Regarding claims 10-12, 23-25 and 46-48, Kerns discloses the first shielding device including first and second surfaces, wherein the conductive material disposed on the first surface and the first shielding device positioned so that the first surface faces the first core portion and the conductive material is in contact with the first core element. Kerns further discloses the second shielding device including first and second

surfaces, wherein the conductive material disposed on the first surface and the second shielding device positioned so that the first surface faces the second core element and the conductive material is in contact with the second core element.

Kerns inherently discloses the transformer can be used in a power supply circuit having a switching circuit and a rectifying circuit. Pp. 2-3.

This ground of rejection is respectfully traversed as applied to the claims as amended.

"It is well settled that anticipation under 35 U.S.C. 102 requires the presence in a single reference of all of the elements of a claimed invention." *Ex parte Chopra*, 229 U.S.P.Q. 230, 231 (BPA&I 1985) and cases cited.

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

"This court has repeatedly stated that the defense of lack of novelty (i.e., 'anticipation') can only be established by a single prior art reference which discloses each and every element of the claimed invention." *Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984), citing five prior Federal Circuit decisions since 1983 including *Connell*.

In a later analogous case the Court of Appeals for the Federal Circuit again applied this rule in reversing a denial of a motion for judgment n.o.v. after a jury finding that claims were anticipated. *Jamesbury Corp. v. Litton Industrial Prod., Inc.*, 225 U.S.P.Q. 253 (Fed. Cir. 1985).

After quoting from *Connell*, "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim," 225 U.S.P.Q. at 256, the court observed that the patentee accomplished a constant tight contact in a ball valve by a lip on the seal or ring which interferes with the placement of the ball. The lip protruded into the area where the ball will be placed and was thus deflected after the ball was assembled into the valve. Because of this constant pressure, the patented valve was described as providing a particularly good seal when regulating a low pressure stream. The court quoted with approval

from a 1967 Court of Claims decision adopting the opinion of then Commissioner and later Judge Donald E. Lane:

[T]he term "engaging the ball" recited in claims 7 and 8 means that the lip contacts the ball with sufficient force to provide a fluid tight seal. \*\*\* The Saunders flange or lip only sealingly engages the ball 1 on the upstream side when the fluid pressure forces the lip against the ball and never sealingly engages the ball on the downstream side because there is no fluid pressure there to force the lip against the ball. The Saunders sealing ring provides a compression type of seal which depends upon the ball pressing into the material of the ring. \*\*\* The seal of Saunders depends primarily on the contact between the ball and the body of the sealing ring, and the flange or lip sealingly contacts the ball on the upstream side when the fluid pressure increases. 225 U.S.P.Q. at 258.

The reference fails to disclose the shielding device having an electrically conductive portion on a surface thereof electrically connected to a drain wire for conducting capacitive displacement current back to their source as called for by all the claims. Accordingly, withdrawal of the rejection of claims 1-3, 5, 10-12, 14-16, 18, 23-25, 38, 39, 41 and 46-48 as anticipated by the reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the reference regarded as corresponding to the shielding device having an electrically conductive portion on a surface thereof electrically connected to a drain wire for conducting capacitive displacement currents back to their source.

The office action states:

Claims 4, 17, 26-30, 35-37 and 49-52, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerns in view of Fischer et al. [US 3,376,531] Kerns discloses the instant claimed invention except for the specific use of the transformer in an electronic/electrical device or apparatus and the specific of the conductive pattern.

The specific intended use of the transformer in a power supply of an electronic or electrical device would have been an obvious design consideration based on the intended applications/environments use.

Fischer et al. discloses a shielding device [figure 3] comprising:

- an insulating layer;
- at least one conductive layer [54, 80, 82] disposed on the insulating layer; wherein the conductive layer form of a plurality of parallel wires

and connecting wires interconnecting the parallel wires; and - an electrical drain wire [90] connected to the conductive layer.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a drain wire connected to the shielding device of Kerns, as suggested by Fischer et al., for the purpose of providing better shielding for the device.

The specific arrangement of the conductive wires [traces] would have been an obvious design consideration for the purpose of reducing the thickness of the shielding device. Pp.3-4

This ground of rejection is respectfully traversed as applied to the claims as amended. The primary reference does not disclose any form of grounding of the shield or mention capacitive displacement currents. It is therefore impossible to combine the primary and secondary references to meet the limitations of these rejected claims.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992). "Although we find nothing before us indicating why it would be desired to combine the references in the manner urged by the examiner, it is clear to us that such a modification by itself would not result in that which is set forth in the claims." *Ex Parte Kusko*, 215 U.S.P.Q. 972, 974 (BPA&I 1981).

That it is impossible to combine the references to meet the limitations of these claims is reason enough for withdrawing the rejection of them. Accordingly, withdrawal of the rejection of claims 4, 17, 26-30, 35-37 and 39-52 as unpatentable over Kerns as a primary reference in view of Fischer as a secondary reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in either reference disclosing a shielding device having an

electrically conductive portion on a surface thereof electrically connected to a drain wire for conducting capacitive displacement currents back to their source.

The office action states:

Claims 6-9, 19-22, 31-34, 42-45 and 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerns in view of Kanbara et al. [US 6,197,408].

Kerns discloses the instant claimed invention except for the specific material for the shielding device.

Kanbara et al. discloses a shielding device comprising an insulating layer [3] and a conductive layer [2] formed on the insulating layer, wherein the conductive layer formed of indium tin oxide.

It would have been obvious to one having ordinary skilled in the art at the time the invention was made to indium tin oxide for the conductive layer of Kerns, as suggested by Kanbara et al., for the purpose of improving shielding.

Carbon impregnated polymer is a well known material use in semiconductive/insulating substrate.

The specific surface resistivity would have been an obvious design consideration for the purpose of enhancing resistivity in the shielding device. Pp. 4-5.

This ground of rejection is respectfully traversed as applied to the amended claims. The primary references does not disclose any form of grounding the shield or mention capacitive displacement currents. Accordingly, it is impossible to combine the primary and secondary reference to meet the limitations of these rejected claims. That is reason enough for withdrawing the rejection of them. Accordingly, withdrawal of the rejection of claim 6-9, 19-22, 31-34, 42-45 and 53-54 as unpatentable over Kerns as a primary reference in view of Kanbara as a secondary reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in either reference disclosing a shielding device having an electrically

conductive portion on a surface thereof electrically connected to a drain wire for conducting capacitive displacement currents back to their source.

In view of the foregoing amendments, authorities, remarks and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. If the Examiner believes the application is not in a condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at 617-521-7014 to discuss what additional steps are believed necessary to place the application in a condition for allowance.

Please apply any other charges or credits to deposit account 06-1050, order 02103-415001.

Respectfully submitted,  
FISH & RICHARDSON P.C.

19 October 2007  
Date: \_\_\_\_\_

/charles hieken/  
\_\_\_\_\_  
Charles Hieken  
Reg. No. 18,411  
Attorneys for Application Owner

Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906